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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,054	01/15/2002	Etienne Georges Maze	003744-02	2937
7590	04/26/2005		EXAMINER	
Brenda L. Havel Metal Coatings International Inc. 275 Industrial Parkway Chardon, OH 44024			LAVILLA, MICHAEL E	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,054

Applicant(s)

MAZE ET AL.

Examiner

Michael La Villa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20050201.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:
2. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See the reasons of record in the Office Action mailed on 28 October 2004 and the comments below.
4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
5. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. See the reasons of record in the Office Action mailed on 28 October 2004 and the comments below.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
8. A person shall be entitled to a patent unless –
 - (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. (f) he did not himself invent the subject matter sought to be patented.

10. Claims 1 and 5-8 are rejected under 35 U.S.C. 102(a or b or f) as being

anticipated by Applicant's Admissions with respect to Eckart STAPA 4ZnAl7.

See the reasons of record in the Office Action mailed on 28 October 2004 and the comments below.

11. Claims 2 and 3 are rejected under 35 U.S.C. 102(a or b or f) as being anticipated

by Applicant's Admissions with respect to Eckart STAPA 4ZnSn30. See the reasons of record in the Office Action mailed on 28 October 2004 and the comments below.

Response to Amendment

- I. In view of applicant's arguments, applicant traverses the section 112, first paragraph rejection of the Office Action mailed on 28 October 2004. Applicant argues that currently presented Claim 7 parallels original Claim 7. However, original Claim 7 specified an amount of zinc. Applicant argues that currently presented Claim 7 somehow indirectly claims an amount of zinc. It is unclear what amount of zinc the currently presented claims indirectly claim. Applicant argues that the standard for new matter is whether one of ordinary skill in the art can recognize by reading the Specification whether applicant invented the claimed subject matter. This statement

of law however does not address the factual basis for concluding that applicant has met this standard. Applicant has not been able to point to a description of the claimed subject matter in the Specification for the claims as now presented.

Since there is no apparent description, it is unclear what is the basis for concluding that one of ordinary skill can recognize that applicant invented the claimed subject matter. Applicant's original disclosure pertained to zinc alloys having greater than 50 weight percent zinc. Applicant has provided no supplementary showing or arguments in support of a claim having less than this amount of zinc. Rejection is maintained.

- II. In view of applicant's amendments and arguments, applicant traverses the section 112, second paragraph rejection of the Office Action mailed on 28 October 2004. Applicant argues that the claims make no admission of prior art. As well, applicant argues that the claimed format simply reflects a combination claim. However, applicant has failed to explain why these claims, presented in Jepson format, do not constitute an admission of prior art. Applicant has apparently provided no "credible reason" for concluding that these claims do not constitute an admission of prior art. See MPEP 2129 (part III) and 608.01(m). Moreover, even to the extent that

these claims are interpreted simply as a combination claim, the point of the rejection is that it is unclear what are the elements being combined. For example, with respect to Claim 1, it is clear that the claim requires zinc alloy in flake form as specified, but it is unclear what other elements are required. Is there simply required a liquid medium that suspends the zinc alloy in flake form, which combination of medium and flake upon curing results in corrosion resistance to a substrate? With respect to the meaning of "curing," applicant explains that no curing agent is necessarily present in the composition and that curing refers to "chemical or physical processes" Since the composition merely is described as containing liquid suspended zinc alloy flake, in Claim 1, for example, it is unclear what is the "curing" that applicant is referring to. Does the fusion of zinc alloy flakes on a substrate to form a protective layer constitute "curing" of zinc alloy flakes? It is unclear what compositional limitation is required to satisfy a composition that is "adapted to curing on" a substrate. Applicant's comments suggest that heating is necessarily required to perform "curing". Is this an implied limitation in the claims?

III. In view of applicant's amendments and arguments, applicant traverses the section 102 rejection over Applicant's Admissions with respect to Eckart STAPA 4ZnAl7 in the Office Action mailed on 28 October 2004. Applicant contends that this paste is not encompassed by the claims as the paste is merely a component of the claimed composition. However, the paste is described as comprising zinc flake of the required alloy composition and liquid, which are the necessary claim elements. No specific amount of liquid medium is claimed that precludes the paste from satisfying the claim limitations. Applicant's contends that the pastes are not coatings. However, the claim does not encompass a coating, but rather a composition. Applicant argues that the pastes are not available prior art. With respect to the Declaration of 11 October 2004, applicant explains that an Exhibit D was provided. However, no such exhibit is apparently provided. Applicant is welcome to point out at what page the exhibit is found in applicant's IFW. Applicant contends that the word "partnership" was used only in a financial sense. While this may be so, absent affidavit proof to the contrary, the presumption that a different inventive entity is involved is not inappropriate. Applicant contends that the Declaration of 11

October 2004 addresses the issue of inventorship of the pastes. However, since only two of the named inventors have filed a declaration, the proof is inadequate. To obviate the 102(a) rejection the inventive entities of the paste and the present application must be the same and applicant has not provided proof that the same inventive entities were involved. With respect to the section 102(b) on-sale bar rejection, applicant falls back on the argument that the paste is only a component of the claimed subject matter. This argument has already been addressed. Rejection is maintained.

- IV. In view of applicant's amendments and arguments, applicant traverses the section 102 rejection over Applicant's Admissions with respect to Eckart STAPA 4ZnSn7 in the Office Action mailed on 28 October 2004. Applicant has traversed this rejection for most of the same reasons as the rejection with respect to Eckart STAPA 4ZnAl7. Since those grounds of traversal have been addressed above, no further discussion is warranted here. With respect to antecedent support for Claims 2 and 3 in the priority application at page 5, lines 5-7, this cited portion does not appear to provide support for or even relate to the claimed subject matter. In the paragraph at the bottom of page 5, the claimed subject matter

does not appear to be described either. Applicant has provided no supplemental evidence or arguments that justify relying on this paragraph as supporting the invention as now claimed. Hence, the critical date is one year before the application filing date of January 15, 2002. Rejection is maintained.

- V. In view of applicant's amendments and arguments, applicant traverses the section 103 rejection over Kaliardos in view of Applicant's Admissions of the Office Action mailed on 28 October 2004. Rejection is withdrawn in view of the argument that Kaliardos teaches flakes of separate metal type rather than alloy flake.

Conclusion

12. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Tuesday, Thursday, and alternating Fridays.
15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 **MICHAEL E. LAVILLA PH.D.**
PRIMARY EXAMINER

Michael La Villa
14 April 2005